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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,916	08/28/2003	Ray-Ling Hsiao	BHT-3111-356	5747

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/649,916	Applicant(s) HSIAO, RAY-LING	
	Examiner Ruth C Rodriguez	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☒ Claim(s) 4 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 29 December 2003 has been considered for this Office Action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sungberg (US 5,179,765).

An improved paper clip comprises a first clipping piece (12), a second clipping piece (16) and a support beam (18). The first clipping piece has a thin plane shape with a sunken slot (14) for placing documents (40) and being a lower part of the paper clip (Figs. 1-4). The sunken slot being as a hollow type (Figs. 1-4). The second clipping piece has a thin plane shape and being an upper part of the paper clip (Figs. 1-4). The second clipping piece is protruded downward to the sunken slot of the first clipping piece (Figs. 1-4). The second clipping piece is smaller than the sunken slot of the first clipping piece (Figs. 1-4). The support beam has a vertical plane with certain height and individually connecting to the first and second clipping pieces in top view (Figs. 1-

4). Connected ends of the support beam and the clipping pieces are located on an opposite side to a side where documents being inserted in a rear end of said sunken slot of the first clipping piece being merged with the support beam (Figs. 1-4).

The certain height of support beam is available for different thicknesses of documents (Figs. 1-4).

4. Claims 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirzel (US 5,214,825).

An improved paper clip (10) comprises a first clipping piece (12), a second clipping piece (14) and a support beam (18). The first clipping piece has a thin plane shape with a sunken slot (22) for placing documents and being a lower part of the paper clip (Figs. 1-10). The sunken slot being as a hollow type (Figs. 1-10). The second clipping piece has a thin plane shape and being an upper part of the paper clip (Figs. 1-10). The second clipping piece is protruded downward to the sunken slot of the first clipping piece (Fig. 7). The second clipping piece is smaller than the sunken slot of the first clipping piece (Figs. 7-10). The support beam has a vertical plane with certain height and individually connecting to the first and second clipping pieces in top view (Figs. 1-10). Connected ends of the support beam and the clipping pieces are located on an opposite side to a side where documents being inserted in a rear end of said sunken slot of the first clipping piece being merged with the support beam (Figs. 1 and 2).

The certain height of support beam is available for different thicknesses of documents (Figs. 1-10).

The first clipping piece has a thinner portion at a front end where documents are inserted (Figs. 1-10).

The second clipping piece has a recessed area with a depth of around 0.01 to 1.0 mm (Figs. 1-10).

5. Claims 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al. (US 4,761,935).

An improved paper clip (10) comprises a first clipping piece (14), a second clipping piece (12) and a support beam (21). The first clipping piece has a thin plane shape with a sunken slot and being a lower part of the paper clip (Figs. 1-6). The sunken slot being as a hollow type (Figs. 1-6). The second clipping piece has a thin plane shape and being an upper part of the paper clip (Figs. 1-6). The second clipping piece is protruded downward to the sunken slot of the first clipping piece (Figs. 1-6). The second clipping piece is smaller than the sunken slot of the first clipping piece (Figs. 2 and 3). The support beam has a vertical plane with certain height and individually connecting to the first and second clipping pieces in top view (Figs. 1 and 4). Connected ends of the support beam and the clipping pieces are located on an opposite side to a side where documents being inserted in a rear end of said sunken slot of the first clipping piece are merged with the support beam (Figs. 1-6).

The certain height of support beam is available for different thicknesses of documents (Figs. 1-6).

The first clipping piece has a thinner portion at a front end where documents are inserted (Fig. 4).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. in view of Hirzel.

King disclose a clip comprises a first clipping piece (14), a support beam (21) and a second clipping piece (12). The first clipping piece has first and second ends along a length direction (Figs. 1-4). The first clipping piece has a top surface and a slot (18) therethrough. The slot extends from the first end along the length direction to a position apart from the second end such that a length of the slot is substantially shorter than a length of the first clipping piece (Figs. 1-4). The slot further has a width smaller than a width of the first clipping piece (Figs. 1-4). The support beam has an inner surface adjoining the slot, an outer surface opposite to the inner surface, a lower side and an upper side (Figs. 1-4). The support beam has its lower side adjoined to the first end of the first clipping piece and extending along a height direction that is perpendicular to the length direction (Figs. 1-4). The lower side of support beam further has a width that is substantially the same as that width of the first clipping piece (Figs. 1-4). The second clipping piece has a fixed end and a free end along the length direction (Figs. 1-4). The second clipping piece has its fixed end adjoined to the upper side of the support beam and extends along the length direction in such a manner that a length distance between

the free end and the support beam is no longer than the length of the slot (Figs. 2 and 3). The second clipping piece further has a width that is smaller than the slot (Figs. 2 and 4). The inner surface of the support beam is a flat plane in perpendicular to the length direction such that the inner surface substantially provides a guiding function when the document is received between the first and second clipping pieces so as to make a leading edge of the document being flush with the inner surface (Figs. 1-6). A projection of the first end of the first clipping piece does not overlap with a projection of the fixed end of the second clipping piece in the height direction (Figs. 2 and 3). The first end of the first clipping piece and the fixed end of the second clipping piece are both adjoined to the inner surface such that the outer surface of the support beam substantially forms part of the outer contour of the paper clip (Figs. 1-4). King fails to disclose that the second clipping piece has a curved part that is partially located within the slot. However Hirzel teaches a clip (10) comprises a first clipping piece (12), a support beam (18) and a second clipping piece (14). The first clipping piece has first and second ends along a length direction (Figs. 1-10). The first clipping piece has a top surface and a slot (22) therethrough. The slot extends in between the first end and the second end such that a length of the slot is substantially shorter than a length of the first clipping piece (Figs. 7-10). The slot further has a width smaller than a width of the first clipping piece (Figs. 7-10). The support beam has an inner surface adjoining the slot, an outer surface opposite to the inner surface, a lower side and an upper side (Figs. 1-10). The support beam has its lower side adjoined to an end of the slot of the first clipping piece and extending along a height direction that is perpendicular to the length

direction (Figs. 1-10). The lower side of support beam further has a width that is substantially the same as that width of the first clipping piece (Figs. 1-10). The second clipping piece has a fixed end and a free end along the length direction (Figs. 1-10). The second clipping piece has its fixed end adjoined to the upper side of the support beam and extends along the length direction in such a manner that a length distance between the free end and the support beam is no longer than the length of the slot (Figs. 7-10). The second clipping piece has a curved part (34) that is partially located within the slot (Fig. 5 and 7). The second clipping piece further has a width that is smaller than the slot (Figs. 7-10). The inner surface of the support beam is a flat plane in perpendicular to the length direction such that the inner surface substantially provides a guiding function when the document is received between the first and second clipping pieces so as to make a leading edge of the document being flush with the inner surface (Figs. 1 and 2). The first end of the first clipping piece and the fixed end of the second clipping piece are both adjoined to the inner surface such that the outer surface of the support beam substantially forms part of the outer contour of the paper clip (Figs. 1-10). The curved part of the second clip piece is partially located within the slot allows easy gripping (C. 3, L. 15-18). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the curved part disclosed that is partially located within the slot as taught by Hirzel in the clip disclosed by King. Doing so, allows easy grip as taught by Hirzel.

The top surface of the first clipping piece disclosed by King has a thinner portion at the second end for receiving at least a document therefrom (Fig. 4).

Hirzel also teaches that:

The top surface of the first clipping piece has a thinner portion at the second end for receiving at least a document therefrom (Figs. 1-10).

The second clipping piece has a recessed area formed on an upper surface thereof (Figs. 1-10). The recessed area has a depth of around 0.01 to 1.0 mm (Figs. 1-10).

Allowable Subject Matter

8. Claim 4 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hart (US 3,502,251), Tsuji (US D311,212), Sungberg (US 5,179,765), Hirzel (US 5,214,825), Rosen (US D464,994 S) and Spoto (US 6,698,695 B10) are cited to show state of the art with respect to clips having some of the features being claimed by the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

RCR
rcr

December 10, 2004


ROBERT J. SANDY
PRIMARY EXAMINER